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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaiyara	45010005211	2222
7590 William S. Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151		09/02/2008	EXAMINER GIARDINO JR, MARK A	
			ART UNIT 2185	PAPER NUMBER
			MAIL DATE 09/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,871

Applicant(s)

MUKAIHARA ET AL.

Examiner

MARK A. GIARDINO JR

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/13/2008 has been entered.

The Examiner acknowledges the applicant's submission of the amendment dated 3/28/2008. At this point, claims 9, 11, 12, 13, and 15 have been amended and no claims have been added. Thus, claims 9-15 are pending in the instant application.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyle (US 2001/0041021).

Regarding Claim 9, Boyle teaches a memory device of a portable type comprising: a terminal capable of being connected to an interface mounted on a host machine and capable of data input/output from/to said host machine (I/O device 122, connected to host machine 110 via connection 130), and a storage element for storing data which include: at least one of image data and audio data (note how JPEG images are stored in computer memory 220 in paragraph 0032), reproduction program data for said host machine to reproduce at least one of said image data and audio data (see reproduction program description in paragraph 0032, also note the storage element can store the reproduction program and transfer it to the host, see paragraph 0010 and how the imaging conduit that contains the reproduction program is installed on the PC without the need for user interaction, i.e., when the storage element is first connected to the host), and execution program data for said host machine to execute said reproduction program using said reproduction program data (inherently present, since the host machine executes the reproduction program as described in paragraph 0032) and a writing program to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal that said host machine detects a connection of said terminal to said interface (the sync manager runs after the device is connected, as described in paragraph 0010, also see the description of the write program that uploads data from a personal computer 110 to the handheld electronic device 124, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is selected by a user ("the sync manager also provides the user the capability to change

the data on one device...and subsequently synchronize the changed data with data located on the computing device", Paragraph 0024 in Boyle).

Regarding Claim 10, Boyle teaches a portable memory device as described in Claim 9, wherein the host machine can activate said execution program in response to said detection signal to read and reproduce at least one of said image data and audio data stored in said memory element (the sync manager runs after the device is connected, as described in paragraph 0010, also see the description of uploading data from a personal computer to the handheld electronic device, paragraph 0036), when said host machine previously stores at least said reproduction program data and execution program data (imaging conduit 310 of the sync manager, installed on the host, paragraph 0010), and when said terminal is connected to said interface in the state that said storage element stores at least one of said image data and audio data (see Figure 6 and particularly steps 614, 618, and 620, where if the storage element stores an image and is connected, the imaging conduit that contains the reproduction program is run).

Regarding Claim 11, Boyle teaches a recording medium for storing a computer-executable program, the program having program code comprising:

a detecting step of detecting detection signal indicating that a terminal of a portable memory device is connected to said interface (see how the sync manager runs after the device is connected, as well as an additional description in paragraph 0010 how the device runs without any need for user interaction); and

an executing step of executing a program in a reproduction program data for reproducing at least one of image data and audio data stored in said memory device, in response to said detection signal (see description of how the imaging conduit reproduces the image data in paragraph 0032, also note that the host executes this program, and thus an executing step is inherently present); and

a writing step to write at least one of said image data and audio data from a host machine to said storage element (see description of writing the data from a personal computer to the handheld electronic device, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is selected by a user ("the sync manager also provides the user the capability to change the data on one device...and subsequently synchronize the changed data with data located on the computing device", Paragraph 0024 in Boyle).

Regarding Claim 13, Boyle teaches a data processing system comprising:

a host machine having an interface capable of data input/output (computing device 110), and a portable memory device comprising a terminal capable of being connected to said interface (paragraph 0020), and a storage element for storing at least one of image data and audio data (paragraph 0019), reproduction program data for said host machine to reproduce at least one of said image data and audio data (see reproduction program description in paragraph 0032, also note the storage element can store the reproduction program and transfer it to the host, see paragraph 0010 and how the imaging conduit that contains the reproduction program is installed on the PC without the need for user interaction, i.e., when the storage element is first connected to

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the host), execution program data for said host machine to execute a program in said reproduction program data in response to a detection signal that said host machine detects a connection of said terminal to said interface (see how the sync manager runs after the device is connected, as well as an additional description in paragraph 0010 how the device runs 'without any need for user interaction'), and a writing program to write at least one of said image data and audio data from said host machine to said storage element (see description of writing data from a personal computer to the handheld electronic device, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is selected by a user ("the sync manager also provides the user the capability to change the data on one device...and subsequently synchronize the changed data with data located on the computing device", Paragraph 0024 in Boyle).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in view of AppleCare Document: 122014.

Regarding Claim 12, Boyle teaches all limitations of Claim 11 as described above, wherein the program has code comprising

an outputting step of outputting at least one of said image data and audio data to said portable memory device (see description of outputting data from a personal computer to the handheld electronic device, paragraph 0036 in Boyle).

However, while Boyle mentions that images and 'other such data' (paragraph 0008) may be transferred across to the portable media device (also see paragraph 0036 where image data is downloaded to the portable device from a host device), he does not give an example of what this 'other data' may be. Apple's iPod, however, enables users to download software from Apple that is transferred from a host machine to the iPod portable memory device automatically once it is connected to the host machine (see first paragraph of AppleCare Document: 122014). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to add a controlling step of controlling to output said image reproduction and execution data onto the host computer and to transfer this program to the handheld device during the outputting step just as the iPod Updater has a controlling step of controlling to output audio reproduction and execution data. The motivation for this is that it keeps software programs flexible, and any minor bug in a program on a handheld device would be able to be fixed by uploading to the handheld device a new version of software from the host (see AppleCare Document: 122014 for a list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle teaches all limitations of Claim 13 as addressed above. Boyle clearly has a network (218 in Boyle) in his system, but does not explain what data could be transferred over the network. Kahn teaches a network over which images are shared, including an external apparatus (image server 331-333 in Kahn). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains that Kahn's network could be the network in Boyle. In this combination, when a device (such as handheld device 110) is connected to a host machine (such as 120 in Boyle) a program (such as the program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082) is run that uploads images to the external apparatus. The motivation for this comes from Kahn, who states that his network provides the benefits of automatic organization and easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle teaches all limitations of Claim 9 as addressed above. Boyle teaches a memory device of a portable type that can store images as well as programs for exchanging these images, but does not teach displaying these images as icons or as a reduced image of a file. However, Sesek teaches a technique that displays reduced images, or "thumbnails" of each image that can be displayed by a host

machine (see paragraphs 0008-0011 in Sesek). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to integrate this display system into the writing program that writes selected files to a portable memory device (such as that described in paragraph 0036 of Boyle). Motivation for this comes from Sesek, who states that thumbnails 'are useful for indicating the contents of a page or image' (paragraph 0007 in Sesek) and also that they allow the user 'to easily select pages or images for viewing' (paragraph 0006 in Sesek). Thus, by integrating Sesek's technique into the write program, additional benefits are obtained.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Rejections - USC 102/103

Regarding the argument regarding claims 1, 11, and 13 that Boyle does not teach at least one of the image data and audio data to be reproduced is selected by a user, it has been considered but is not persuasive. While a user cannot select the image or audio data the user wishes to reproduce once the host and handheld electronic devices are connected to each other, a user may change data and sync the changed data as described in paragraph 0024 in Boyle ("the sync manager also provides the user the capability to change the data on one device...and subsequently synchronize the changed data with data located on the computing device"), thus Boyle teaches that a user selects image data to be reproduced.

CLOSING COMMENTS

Conclusion

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a first action on the merits and are subject of a first action non-final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino
/M.G./

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Patent Examiner

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September 2, 2008

/Sanjiv Shah/

Supervisory Patent Examiner, Art Unit 2185